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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,008	03/03/2000	Roger McAulay	21920-708	6539

21971 7590 12/03/2002

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EXAMINER

RUDY, ANDREW J

ART UNIT	PAPER NUMBER
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3627

17

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/519,008

Applicant(s)

MCAULAY ET AL.

Examiner

Andrew Joseph Rudy

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance: See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 1-30 and 32-34 are pending. Applicant cancelled claim 31 in the 6 September 2002 Amendment.

#### ***Priority***

2. From page 1 of 2 from Applicant's Declaration, Applicant's claim for domestic priority under 35 U.S.C. 119(h) is acknowledged. However, there is no domestic priority based under 35 U.S.C. 119(h). However, Applicant may claim domestic priority under 35 U.S.C. 119(e). As is, Applicant's claim for domestic priority is not recognized.

#### ***Response to Amendment***

3. Claims 1-3, 6-8, 11, 14-18, 24-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleiman.

Applicant's assertions regarding the master list are noted. However, the term is not defined in juxtaposition with the other claim language to define over Kleiman. As is the master list of Kleiman may consist of all the titles that Kleiman uses to select the electronic titles stored on the jukebox. One may select from the local list or master list. One need not select from both

to fully encompass Applicant's claim language. Applicant's assertions that "Kleiman teaches that the direct on-line access of songs would be cost prohibitive" is not agreed with. Review of Kleiman, column 3, lines 20-25, and col. 9, lines 57-62, recites does not positively state that the system would be cost prohibitive. Kleiman does note "The cost to transfer the large files, including songs, can be prohibitive for a computerized jukebox" and "direct on-line access, would naturally be more expensive" and thus allows for such a system, cognizant of attendant costs. However, Kleiman does not flat out assert that its system would be cost prohibitive. As is, Kleiman's system may be used via direct on-line access. It is deemed within the broad concept of being an on-demand system.

Applicant's assertion of long sought need and commercial success of Applicant's invention is not convincing. Nothing in the record supports such an assertion.

4. Claims 1-3, 6-8, 11, 14-18, 24-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Official Notice referenced from Paper No. 8, page 3, paragraph no. 6.

Applicant's remarks are noted. However, the date of March 2, 1999 is not at issue. Applicant's claim for domestic priority has not been recognized, as noted above. However, even if Applicant were to correct the deficient claim for domestic priority, the provisional application 60/145,607 has a listed filing date of 26 July 1999. Thus, Applicant's remarks are not relevant, nor convincing as the March 2, 1999 date is not at issue.

Art Unit: 3627

5. Claims 5, 9, 12, 13 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleiman as applied to claims 1-3, 6-8, 11, 14-18 and 24-34 above, and further in view of Bernstein. Applicants basic premise regarding Kleiman is not convincing. The master list of Kleiman reads upon Applicants' claim language.

To modify Kleiman by providing a recognition device and card reader as disclosed by Bernstein, would have been obvious to one of ordinary skill in the art. Also, using well known infrared (IR) data transfer means would have been obvious to one of ordinary skill in the art. Doing so would provide well known identity recognition, content processing means and data transfer means for the system of Kleiman.

6. The rejections from Paper No. 11 mailed on May 9, 2002, based upon Billock and Cook, are withdrawn.

7. Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwek, US 6,248,946.

Dwek discloses a multimedia content delivery comprising a master list 110 and a local list 344 that may be accessed via a computer system. To provide the content delivery coupled to an on demand wide area network or local area network for Dwek would have been obvious to one of ordinary skill in the art, as would be using infrared data transfer. Doing such would use well-known computer tools available to a computer user using the system provided by Dwek.

8. Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads et al., US 6,442,285.

Rhodes discloses a multimedia content, e.g. music, delivery comprising a master list and a local list, e.g. col. 8, that may be accessed via a gui computer system on the Internet and stored at a web site and protected by ID. To provide the content delivery coupled to an on demand wide area network or local area network for Rhodes would have been obvious to one of ordinary skill in the art, as would be using infrared data transfer. Doing such would use well-known computer tools available to a computer user using the system provided by Rhodes.

9. Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berhan, US 6,487,145.

Berhan discloses a multimedia content, e.g. music, delivery comprising a master list and a local list that may be accessed via a computer system and downloaded over the Internet. To provide the content delivery coupled to an on demand wide area network or local area network for Berhan would have been obvious to one of ordinary skill in the art, as would be using infrared data transfer. Doing such would use well-known computer tools available to a computer user using the system provided by Berhan.

9. Claims 1-30 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al., US 5,931,901.

Wolfe discloses music on demand from the Internet. To provide the content delivery coupled to an on demand wide area network or local area network for Rhodes would have been obvious to one of ordinary skill in the art, as would be using infrared data transfer. Doing such would use well-known computer tools available to a computer user using the system provided by Wolfe.

10. Further pertinent references of interest:

Wolfe et al., US 6,161,142, discloses delivering media content over the Internet.

Sitrick, US 6,084,168, discloses a musical workstation used over the Internet.

Shannon, Victoria, in The Washinton Post, July 26, 1995 discloses on on-line demand for a music juke box over the Internet.

Scibora, US 2002/0035644, discloses method for compressing digital content over a computer network.

Rouchon, US 2001/0025259, discloses a system and method for distributing music to entities over a computer network.

*Conclusion*

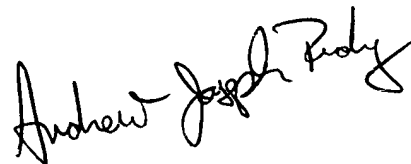
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808. The examiner can normally be reached on Tuesday thru Friday, 7:30 a.m until 6 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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December 2, 2002

A handwritten signature in black ink, reading "Andrew Joseph Rudy". The signature is written in a cursive, flowing style with a large, stylized "R" at the end.